REMARKS/ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

35 U.S.C. § 103(a) Rejections

Examiner rejected claims 1-2, 4-11, 13-23, and 25-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,396,631 (hereinafter "Hayashi") in view of U.S. Patent 5,815,720 (hereinafter "Buzbee").

Examiner rejected claims 3, 12 and 24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,396,631 (hereinafter "Hayashi") in view of U.S. Patent 5,815,720 (hereinafter "Buzbee"), and further in view of U.S. Patent 5,966,538 (hereinafter "Granston).

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Applicant's independent claims include limitations not disclosed in Hayashi or Buzbee. Therefore, applicant's independent claims are patentable over Hayashi in view of Buzbee.

For example, applicant's independent claims include the newly added claim

limitation, or a limitation similar thereto, of:

> generating a machine language routine in a computer system
> from the intermediate language routine;
> executing the machine language routine from the main memory
> of the first computing system using the initialized values;
> measuring a characteristic of the execution;
>
> . . .
>
> evaluating whether a stopping criterion after said executing is
> met and if not, repeating said performing through said measuring,
> saving the machine language routine having a best measured
> characteristic, until the stopping criterion is met wherein said
> characteristic includes at least one of a timing wherein the best
> measured timing is a lowest timing, a machine language routine size,
> and a bus utilization metric. (Applicant's claim 1.)

The newly added claim limitations as show above are neither disclosed nor

suggested in Hayashi or Buzbee. Rather, Hayashi is limited to disclosing: a

compiling apparatus having an optimizing structure determination unit for

determining the number of repetitions of an optimization phase achieved by the

optimizing unit and intermediate representation changing unit and selecting

optimization functions carried out in each of the optimization phases. The

intermediate representations are changed and optimized in each optimization phase

according to the determination by the optimizing structure determination unit.

(Hayashi, col. 3).

Buzbee is limited to disclosing: a dynamic translation to produce profile

information used to optimize object code for an application. In order to produce

optimized object code for the application, source code for the application is

compiled to produce first object code for the application. The first object code is used

in the generation of profile information about the application. (Buzbee, col. 2).

However, there is no disclosure in Hayashi or Buzbee of applicant's claimed:

. . .

> evaluating whether a stopping criterion after said executing is
> met and if not, repeating said performing through said measuring,
> saving the machine language routine having a best measured
> characteristic, until the stopping criterion is met wherein said
> characteristic includes at least one of a timing wherein the best
> measured timing is a lowest timing, a machine language routine size,
> and a bus utilization metric. (Applicant's claim 1.)

Therefore, applicant's claims include limitations not disclosed nor suggested

in Hayashi or Buzbee. As a result, applicant's claims are patentable over Hayashi in

view of Buzbee.

Furthermore, the remaining claims depend from at least one of the

independent claims discussed above, and therefore include the distinguishing

limitations of the independent claims. As a result, applicant's remaining claims are

also patentable over Hayashi in view of Buzbee.

CONCLUSION

Applicant respectfully submits the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.
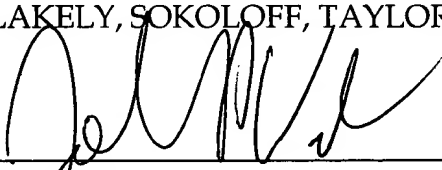
Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 7/6/04

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